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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/619,323	07/14/2003	Lisa K. Jennings	20609/241 (PD 02036/02037)	8249
7590	09/29/2005			EXAMINER HADDAD, MAHER M
Edwin V. Merkel NIXON PEABODY LLP Clinton Square P.O. Box 31051 Rochester, NY 14603			ART UNIT 1644	PAPER NUMBER
DATE MAILED: 09/29/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/619,323	JENNINGS ET AL.
	Examiner Maher M. Haddad	Art Unit 1644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on ____.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-78 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) Claim(s) ____ is/are allowed.
- 6) Claim(s) ____ is/are rejected.
- 7) Claim(s) ____ is/are objected to.
- 8) Claim(s) 1-78 are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on ____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. ____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: ____.

DETAILED ACTION

1. Restriction to one of the following inventions is required under 35 U.S.C. § 121:

- I. Claims 1-4, drawn to a method of interfering with CD9 binding to fibronectin comprising contacting a CD9 protein or polypeptide with an agent that binds to a fibronectin-binding domain of the CD9 protein or polypeptide wherein the agent is an antibody, classified in Class 7.1, subclass 7.1.
- II. Claims 1 and 5-7, drawn to a method of interfering with CD9 binding to fibronectin comprising contacting fibronectin with a polypeptide fragment of CD9 that includes at least a part of a fibronectin-biding domain; classified in Class 435, subclasses 7.1.
- III. Claims 1, 3-4 and 6-8, drawn to a method of interfering with CD0 binding to fibronectin comprising contacting the CD9 protein or polypeptide with an agent that binds to a fibronectin-binding domain f the CD9 protein or polypeptide and contacting fibronectin with a polypeptide fragment of CD9 that includes at least a part of a fibronectin-binding domain; classified in Class 435, subclass 7.1.
- IV. Claims 9-10, 22 and 24, drawn to a method of modifying/*enhancing* adhesion, motility or spreading of CD9-expressing cell on fibronectin comprising modifying CD9 *expression level* comprising transforming the CD9-expressing cell with an expression vector encoding CD9, *in vitro*, classified in Class 435, subclass 6.
- V. Claims 9-10, 22 and 24, drawn to a method of modifying/*inhibiting* adhesion, motility or spreading of CD9-expressing cell on fibronectin comprising modifying CD9 *expression level* comprising transforming the CD9-expressing cell with an expression vector encoding antisense CD9 RNA or siRNA, *in vitro*, classified in Class 435, subclass 6.
- VI. Claims 9, 11-14, 22 and 24, drawn to a method of modifying adhesion, motility or spreading of CD9-expressing cell on fibronectin comprising modifying *CD9 activity* on a CD9 expressing cell comprising contacting CD9 with an agent that binds to the CD EC2 domain wherein the agent is an antibody, *in vitro*, classified in Class 435, subclass 7.21.
- VII. Claims 9, 11, 15-17, 22 and 24, drawn to a method of modifying adhesion, motility or spreading of CD9-expressing cell on fibronectin comprising modifying *CD9 activity* on a CD9 expressing cell comprising contacting fibronectin with one or more polypeptide fragments, *in vitro*, classified in Class 435, subclass 7.21.
- VIII. Claims 9, 11, 18-20, 22 and 24, drawn to a method of modifying adhesion, motility or spreading of CD9-expressing cell on fibronectin comprising modifying *CD9 activity*

on a CD9 expressing cell comprising contacting an integrin colocalized with CD9 on the cell surface with an agent that binds to the integrin, wherein the agent is anti- $\alpha 5\beta 1$ integrin antibody, *in vitro*, classified in Class 435, subclass 7.21.

- IX. Claims 9, 11, 13-14, 16-17, 21-22 and 24, drawn to a method of modifying adhesion, motility or spreading of CD9-expressing cell on fibronectin comprising modifying *CD9 activity* on a CD9 expressing cell comprising contacting CD9 with an agent that binds to CD9 EC2 domain and contacting fibronectin with one or more polypeptide fragments of CD9, *in vitro*, classified in Class 435, subclass 7.21.
- X. Claims 9, 11, 13-14, 19-22 and 24, drawn to a method of modifying adhesion, motility or spreading of CD9-expressing cell on fibronectin comprising modifying *CD9 activity* on a CD9 expressing cell comprising contacting CD9 with an agent that binds to CD9 EC2 domain and contacting an integrin colocalized with CD9 on the cell surface with an agent that binds to the integrin, wherein the agent is anti- $\alpha 5\beta 1$ integrin antibody, *in vitro*, classified in Class 435, subclass 7.21.
- XI. Claims 9, 11, 16-17, 19-22 and 24, drawn to a method of modifying adhesion, motility or spreading of CD9-expressing cell on fibronectin comprising modifying *CD9 activity* on a CD9 expressing cell comprising contacting CD9 with fibronectin with one or more polypeptide fragments of CD9 and contacting an integrin colocalized with CD9 on the cell surface with an agent that binds to the integrin, wherein the agent is anti- $\alpha 5\beta 1$ integrin antibody, *in vitro*, classified in Class 435, subclass 7.21.
- XII. Claims 9, 11, 13-14, 16-17, 19-22 and 24, drawn to a method of modifying adhesion, motility or spreading of CD9-expressing cell on fibronectin comprising modifying *CD9 activity* on a CD9 expressing cell comprising contacting CD9 with an agent that binds to CD9 EC2 domain and CD9 with fibronectin with one or more polypeptide fragments of CD9 and contacting an integrin colocalized with CD9 on the cell surface with an agent that binds to the integrin, wherein the agent is anti- $\alpha 5\beta 1$ integrin antibody, *in vitro*, classified in Class 435, subclass 7.21.
- XIII. Claims 9-10, and 23-24, drawn to a method of modifying/*enhancing* adhesion, motility or spreading of CD9-expressing cell on fibronectin comprising modifying *CD9 expression level* comprising transforming the CD9-expressing cell with an expression vector encoding CD9, *in vivo*, classified in Class 514, subclass 44.
- XIV. Claims 9-10, and 23-24, drawn to a method of modifying/*inhibiting* adhesion, motility or spreading of CD9-expressing cell on fibronectin comprising modifying *CD9 expression level* comprising transforming the CD9-expressing cell with an expression vector encoding antisense CD9 RNA or siRNA, *in vivo*, classified in Class 514, subclass 44.

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XV. Claims 9,11-14, and 23-24, drawn to a method of modifying adhesion, motility or spreading of CD9-expressing cell on fibronectin comprising modifying *CD9 activity* on a CD9 expressing cell comprising contacting CD9 with an agent that binds to the CD EC2 domain wherein the agent is an antibody, *in vivo*, classified in Class 424, subclass 144.1.

XVI. Claims 9, 11, 15-17 and 23-24, drawn to a method of modifying adhesion, motility or spreading of CD9-expressing cell on fibronectin comprising modifying *CD9 activity* on a CD9 expressing cell comprising contacting fibronectin with one or more polypeptide fragments, *in vivo*, classified in Class 424, subclass 185.1 and Class 514, subclass 2.

XVII. Claims 9, 11, 18-20 and 23-24, drawn to a method of modifying adhesion, motility or spreading of CD9-expressing cell on fibronectin comprising modifying *CD9 activity* on a CD9 expressing cell comprising contacting an integrin colocalized with CD9 on the cell surface with an agent that binds to the integrin, wherein the agent is anti- $\alpha 5\beta 1$ integrin antibody, *in vivo*, classified in Class 424, subclass 144.1.

XVIII. Claims 9, 11, 13-14, 16-17, 21 and 23-24, drawn to a method of modifying adhesion, motility or spreading of CD9-expressing cell on fibronectin comprising modifying *CD9 activity* on a CD9 expressing cell comprising contacting CD9 with an agent that binds to CD9 EC2 domain and contacting fibronectin with one or more polypeptide fragments of CD9, *in vivo*, classified in Class 424, subclass 144.1, 185.1 and Class 514, subclass 2.

XIX. Claims 11, 13-14, 19-21 and 23-24, drawn to a method of modifying adhesion, motility or spreading of CD9-expressing cell on fibronectin comprising modifying *CD9 activity* on a CD9 expressing cell comprising contacting CD9 with an agent that binds to CD9 EC2 domain and contacting an integrin colocalized with CD9 on the cell surface with an agent that binds to the integrin, wherein the agent is anti- $\alpha 5\beta 1$ integrin antibody, *in vivo*, classified in Class 424, subclass 144.1.

XX. Claims 9, 11, 16-17, 19-21, 23 and 24, drawn to a method of modifying adhesion, motility or spreading of CD9-expressing cell on fibronectin comprising modifying *CD9 activity* on a CD9 expressing cell comprising contacting CD9 with fibronectin with one or more polypeptide fragments of CD9 and contacting an integrin colocalized with CD9 on the cell surface with an agent that binds to the integrin, wherein the agent is anti- $\alpha 5\beta 1$ integrin antibody, *in vivo*, classified in Class 424, subclass 144.1, 185.1 and Class 424, subclass 144.1, 185.1 and Class 514, subclass 2.

XXI. Claims 9, 11, 13-14, 16-17, 19-21, 23 and 24, drawn to a method of modifying adhesion, motility or spreading of CD9-expressing cell on fibronectin comprising modifying *CD9 activity* on a CD9 expressing cell comprising contacting CD9 with an agent that binds to CD9 EC2 domain and CD9 with fibronectin with one or more

polypeptide fragments of CD9 and contacting an integrin colocalized with CD9 on the cell surface with an agent that binds to the integrin, wherein the agent is anti- $\alpha 5\beta 1$ integrin antibody, *in vivo*, classified in Class 424, subclass 144.1, 185.1 and Class 514, subclass 2.

XXII. Claim 25, drawn to a method of inhibiting proliferation or survival of CD9-expressing cells comprising contacting a cell expressing CD9 with an agent that binds to a CD9 extacellular domain, *in vitro*, classified in Class 435, subclass 7.1.

XXIII. Claims 25-26, drawn to a method of inhibiting proliferation or survival of CD9-expressing cells comprising contacting a cell expressing CD9 with an inhibitor of PI 3-kinase, *in vitro*, classified in Class 435, subclass 7.1.

XXIV. Claims 25-26, drawn to a method of inhibiting proliferation or survival of CD9-expressing cells comprising contacting a cell expressing CD9 with an agent that binds to a CD9 extacellular domain and an inhibitor of PI 3-kinase, *in vitro*, classified in Class 435, subclass 7.1.

XXV. Claims 25 and 34-37, drawn to a method of inhibiting proliferation or survival of CD9-expressing cells comprising contacting a cell expressing CD9 with an agent that binds to a CD9 extacellular domain, *in vivo*, classified in Class 424, subclass 144.1.

XXVI. Claims 25-28 and 34-37, drawn to a method of inhibiting proliferation or survival of CD9-expressing cells comprising contacting a cell expressing CD9 with an inhibitor of PI 3-kinase, *in vivo*, classified in Class 514, subclass 1.

XXVII. Claims 25-28 and 34-37, drawn to a method of inhibiting proliferation or survival of CD9-expressing cells comprising contacting a cell expressing CD9 with an agent that binds to a CD9 extacellular domain and an inhibitor of PI 3-kinase, *in vivo*, classified in Class 424, subclass 144.1 and Class 514, subclass 1.

XXVIII. Claims 25 and 29-37, drawn to a method of inhibiting proliferation or survival of CD9-expressing cells comprising contacting a cell expressing CD9 with an agent that binds to a CD9 extacellular domain and further comprising administering one or more polypeptide fragments of CD9, *in vivo*, classified in Class 424, subclass 144.1 and Class 514, subclass 2.

XXIX. Claims 25-37, drawn to a method of inhibiting proliferation or survival of CD9-expressing cells comprising contacting a cell expressing CD9 with an inhibitor of PI 3-kinase and further comprising administering one or more polypeptide fragments of CD9, *in vivo*, classified in Class 514, subclass 1 and 2.

XXX. Claims 25-37, drawn to a method of inhibiting proliferation or survival of CD9-expressing cells comprising contacting a cell expressing CD9 with an agent that binds to a CD9 extracellular domain and an inhibitor of PI 3-kinase and further comprising administering one or more polypeptide fragments of CD9, in vivo, classified in Class 424, subclass 144.1 and Class 514, subclass 1 and 2.

XXXI. Claims 38-39, drawn to a method of modifying pericellular fibronectin matrix assembly comprising modifying CD9 *expression levels* comprising transforming the CD9-expressing cell with an expression vector encoding CD9, in vitro, classified in Class 435, subclass 6.

XXXII. Claims 38-39, drawn to a method of modifying pericellular fibronectin matrix assembly comprising modifying CD9 *expression levels* comprising transforming the CD9-expressing cell with an expression vector encoding CD9 antisense or siRNA, in vitro, classified in Class 435, subclass 6.

XXXIII. Claims 38, 40-44, drawn to a method of modifying pericellular fibronectin matrix assembly comprising modifying CD9 *activity* on a CD9-expressing cells comprising contacting a CD9 protein or polypeptide of a CD9-expressing cell with an agent that binds to a fibronectin-binding domain of the CD9 protein or polypeptide, in vitro, classified in Class 435, subclass 7.21.

XXXIV. Claims 38, 40-41, 45-47, drawn to a method of modifying pericellular fibronectin matrix assembly comprising modifying CD9 *activity* on a CD9-expressing cells comprising contacting the pericellular fibronectin matrix assembly with one or more polypeptide fragments of CD9, in vitro, classified in Class 435, subclass 7.21.

XXXV. Claims 38, 40-41, 43-44 and 46-48, drawn to a method of modifying pericellular fibronectin matrix assembly comprising modifying CD9 *activity* on a CD9-expressing cells comprising contacting a CD9 protein or polypeptide of a CD9-expressing cell with an agent that binds to a fibronectin-binding domain of the CD9 protein or polypeptide and contacting the pericellular fibronectin matrix assembly with one or more polypeptide fragments of CD9, in vitro, classified in Class 435, subclass 7.21.

XXXVI. Claims 49-50, drawn to a method of modifying invasiveness of a cell through a collagen and/or laminin matrix comprising modifying CD9 *expression level* on a CD9-expressing cell comprising transforming the CD9-expressing cell with an expression vector encoding CD9, *in vitro*, classified in Class 435, subclass 6.

XXXVII. Claims 49-50, drawn to a method of modifying invasiveness of a cell through a collagen and/or laminin matrix comprising modifying CD9 *expression level* on a CD9-expressing cell comprising transforming the CD9-expressing cell with an expression vector encoding CD9 antisense RNA or siRNA, *in vitro*, classified in Class 435, subclass 6.

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XXXVIII. Claims 49, 51-55, drawn to a method of modifying invasiveness of a cell through a collagen and/or laminin matrix comprising modifying CD9 *activity* on a CD9-expressing cell comprising contacting a CD9 protein or polypeptide of a CD9-expressing cell with an agent that binds to a fibronectin-bindign domain of the CD9 protein or polypeptide, *in vitro*, classified in Class 435, subclass 7.21.

XXXIX. Claims 49, 51-52, and 56-58, drawn to a method of modifying invasiveness of a cell through a collagen and/or laminin matrix comprising modifying CD9 *activity* on a CD9-expressing cell comprising contacting the pericellular fibronectin matrix assembly with one or more polypeptide fragments of CD9, *in vitro*, classified in Class 435, subclass 7.21.

XL. Claims 49, 51-52, 54-55, and 57-59, drawn to a method of modifying invasiveness of a cell through a collagen and/or laminin matrix comprising modifying CD9 *activity* on a CD9-expressing cell comprising contacting a CD9 protein or polypeptide of a CD9-expressing cell with an agent that binds to a fibronectin-bindign domain of the CD9 protein or polypeptide **and** the pericellular fibronectin matrix assembly with one or more polypeptide fragments of CD9, *in vitro*, classified in Class 435, subclass 7.21.

XLI. Claims 60-61, drawn to a method of modifying cell-cell interaction comprising modifying CD9 *expression level* on a CD9-expressing cell comprising transforming the CD9-expressing cell with an expression vector encoding CD9, *in vitro*, classified in Class 435, subclass 6.

XLII. Claims 60-61, drawn to a method of cell-cell interaction comprising modifying CD9 *expression level* on a CD9-expressing cell comprising transforming the CD9-expressing cell with an expression vector encoding CD9 antisense RNA or siRNA, *in vitro*, classified in Class 435, subclass 6.

XLIII. Claims 60, 62-66, drawn to a method of modifying cell-cell interaction comprising modifying CD9 *activity* on a CD9-expressing cell comprising contacting a CD9 protein or polypeptide of a CD9-expressing cell with an agent that binds to a fibronectin-bindign domain of the CD9 protein or polypeptide, *in vitro*, classified in Class 435, subclass 7.21.

XLIV. Claims 60, 62-63 and 67-69, drawn to a method of modifying cell-cell interaction comprising modifying CD9 *activity* on a CD9-expressing cell comprising contacting the pericellular fibronectin matrix assembly with one or more polypeptide fragments of CD9, *in vitro*, classified in Class 435, subclass 7.21.

XLV. Claims 60, 61-63, 65-66 and 68-70, drawn to a method of modifying cell-cell interaction comprising modifying CD9 *activity* on a CD9-expressing cell comprising contacting a CD9 protein or polypeptide of a CD9-expressing cell with an agent that binds to a fibronectin-bindign domain of the CD9 protein or polypeptide **and** the

pericellular fibronectin matrix assembly with one or more polypeptide fragments of CD9, in vitro, classified in Class 435, subclass 7.21.

XLVI. Claim 71, drawn to a method of diagnosing sperm-egg fusion infertility comprising obtaining an egg from a female patient and determining the quantity of CD9 expressed on the egg, classified in Class 424, subclass 9.1.

XLVII. Claims 72-75, drawn to a polypeptide that is a fragment of human CD9 and a chimeric protein, classified in Class 530, subclasses 327-330 and 391.3.

XLVIII. Claims 76-78, drawn to an antibody against the polypeptide fragment of CD9, classified in Class 530, subclass 388.24.

2. Groups XLVII and XLVIII are different products. Polypeptides, and antibodies to the polypeptides differ with respect to their structures and physicochemical properties; therefore each product is patentably distinct.

3. Groups I-XLVI are different methods. Various methods of interfering, various methods of modifying, various methods of inhibiting, various methods of treating and a method of diagnosing differ with respect to ingredients, method steps, and endpoints; therefore, each method is patentably distinct.

4. Groups XLVII/(II-III, VII, IX, XI-XII, XVI, , XVIII, XX, XXI, XXVIII-XXX, XXXIV, XXXV, XXXIX, XL, XLIV and XLV) and XLVIII/(I, VI, IX, X, XII, XV, XVIII, XIX, XXIXII, XXIV, XXV, XXVII, XXVIII, XXX, XXXIII, XXXV, XXXVIII, XL, XLIII and XLV) are related as product and process of using. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the antibody of Group XLVIII and the polypeptide fragments of XLVII can be used for affinity purification, in addition to the various methods recited.

5. These inventions are distinct for the reasons given above. In addition, they have acquired a separate status in the art as shown by different classification and/or recognized divergent subject matter. Further, even though in some cases the classification is shared, a different field of search would be required based upon the structurally distinct products recited and the various methods of use comprising distinct method steps. Therefore restriction for examination purposes as indicated is proper. Further, a prior art search also requires a literature search. It is an undue burden for the examiner to search more than one invention.

Species Election

6. Irrespective of whichever group applicant may elect, applicant is further required under 35 US 121 (1) to elect a single disclosed species to which claims would be restricted if no generic claim is finally held to be allowable and (2) to list all claims readable thereon including those subsequently added.

- A. If any one of Groups II-III, VII, IX, XI-XII, XVI, XVIII, XX, XXI, XXVIII-XXX, XXXIV, XXXV, XXXIX, XL, XLIV, XLV or XLVII is elected, applicant is required to elect a single specific polypeptide fragment such as a) SEQ ID NO: 3, b) SEQ ID NO: 4, c) SEQ ID NO: 5 or SEQ ID NO: 6. These sequences are distinct species because their structures and physiochemical property are different; thus each sequence represents patentably distinct subject matter.
- B. If any one of Groups XXV-XXX is elected, applicant is required to elect a condition or disease state involving proliferation or survival of CD9-expressing cells such as those recited in claim 35 and further if applicant elected primary or metastatic cancers, applicant is required to elect a single specific cancer type such as those recited in claim 37. These species are distinct because the pathological conditions differ in etiologies and therapeutic endpoints; thus each condition represents patentably distinct subject matter.

Applicant is required under 35 U.S.C. § 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

7. Applicant is advised that a response to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 C.F.R. § 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. M.P.E.P. § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. § 103 of the other invention.

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8. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

9. The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. **Process claims that depend from or otherwise include all the limitations of the patentable product** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

12. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maher Haddad whose telephone number is (571) 272-0845. The examiner can normally be reached Monday through Friday from 7:30 am to 4:00 pm. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on (571) 272-0841. The fax number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

August 25, 2005



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